

obtained by introducing into a similar host cell a second genetic vector essentially identical to the first genetic vector except that it does not bear said gene insert.

55. The method of Claim 52 wherein examination for a change in the phenotypic characteristic in response to said chemical agent includes comparing the response of the treated cell to the response of a comparable untreated test cell.

56. The method of Claim 52 wherein examination includes comparing the phenotypic response of the treated test cell to that of a comparably treated test cell which does not overproduce the selected protein.

57. The method of Claim 52 wherein examination includes comparing the phenotypic response of the ~~first~~ test cell in the presence of said chemical agent with the phenotypic response of <sup>a</sup> the second test cell in the presence of a known inhibitor or activator of the protein.

58. The method of any one of Claims ~~52~~<sup>53</sup>-57 wherein said change in said phenotypic characteristic in response to said chemical agent is a graded cellular response.

#### REMARKS

The courtesy of the Examiner in granting Applicant and his representatives a pre-examination interview is gratefully acknowledged. As indicated at that interview, Applicant hereby submits new Claims 33-58 which are based on claims in Applicant's issued patents, U.S. Patent Nos. 4,980,281 and 5,688,655 (hereinafter the '281 patent and the '655 patent, respectively). Accordingly, Applicant encloses a terminal disclaimer with respect to the '281 and '655 patents.

As the Examiner is aware, some, **but not all**, of the claims in the '281 and '655 patents were originally declared by the PTO to interfere with the single claim in U.S. Serial

No. 08/953,550 of Berman *et al.* (hereafter "Berman") as set out in Interference No. 104,347.<sup>1</sup>

To expedite prosecution, the claims presented in this application are based **only** on claims in the '281 and '655 patents which were determined **not** to correspond to the count of the interference. *See*, Notice Declaring Interference, Page 32, indicating that Claims 2, 4-14, 19-20 and 24 of the '281 patent and Claims 6, 8 and 14 of the '655 patent do **not** correspond to the count (copy enclosed) and the Interference Initial Memorandum with Attachment, also so-indicating (copy enclosed).

More particularly, in the newly presented claims, one group is directed to a method of determining whether a chemical agent that directly interacts with an enzyme is an inhibitor or activator of that protein as set forth in independent Claims 33 and 43 and the claims dependent thereon. The other group is directed to a method of determining whether a chemical agent, suspected of being an inhibitor or activator of the biological activity of a protein, that directly interacts with that protein is an inhibitor or activator of that protein as set forth in independent Claims 39 and 52 and the claims dependent thereon.

Claim 33 is based on Claim 8 of the '281 patent, and Claim 43 is based on Claim 8 of the '655 patent. Claim 39 is based on Claims 13 and 14 of the '281 patent, and Claim 52 is based on Claim 1 of the '655 patent and Claims 13 and 14 of the '281 patent. Each of the independent claims hereof includes all the elements of the claims on which they are based, a further limitation that the cells or cell lines used in the method are of *mammalian* origin, and

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<sup>1</sup>At present, Berman has no claim corresponding to the count, having been unable to satisfy the requirements of 35 U.S.C. § 135(b) for a timely claim directed to substantially the same subject matter as any of Applicant's patent claims. Berman's unpatentable claim was directed to a method of identifying inhibitors of HIV gp120. Berman is now attempting to add a claim directed to an antibody and have that claim designated as corresponding to a count made up of Claims 1 and 22 of the '281 patent, Claim 5 of the '464 patent, and Claim 1 of the '655 patent.

other recitations made to avoid assertions by third-parties attempting to broaden the scope of the claims. To assist in considering the new claims, a copy of Claims 33 and 43 has been included with the additions relative to Claim 1 of the '281 patent and Claim 1 of the '655 patent, respectively, shown in bold. A similarly marked copy of Claims 39 and 52 has also been included. See, Appendix 1.

Accordingly, support for the subject matter of Claims 33-58 is found, *inter alia*, in the present application and in the earliest priority application, U.S. Serial No. 07/154,206, which specification is identical to the '281 patent, as set forth in the tables below. The independent claims are presented first. No new matter has been presented.

Claim No. or Claim Element**	Application	'281 patent
33	Claim 1; Page 8, Lines 22-31; Claim 8; Page 1, Lines 12-14; Page 4, Lines 20-24	Claim 1; Col. 4, Lines 41-50; Claim 8; Col. 1, Lines 7-10; Col. 2, Lines 46-50
39	Claims 1, 13 & 14; Page 8, Lines 22-31; Page 38, line 33 to Page 39, line 6	Claims 1, 13 & 14; Col. 4; Lines 41-50; Col. 18, lines 9-17
43	Page 8, Lines 22-31; Claim 8; Page 1, Lines 12-14; Page 4, Lines 20-24	Col. 4, Lines 41-50; Claim 8; Col. 1, Lines 7-10; Col. 2, Lines 46-50 (see also Claims 1 and 8 of the '655 patent)
52	Page 8, Lines 22-31; Claims 13 & 14; Page 38, line 33 to Page 39, line 6	Col. 4, Lines 41-50; Claims 13 & 14 (see also Claim 1 of the '655 patent); Col. 18, lines 9-17
chemical agent	Page 13, Lines 3-7; Page 39, Lines 21-26	Col. 6, Lines 29-33; Col. 18, Lines 30-36
agent directly interacts with a protein/enzyme	Page 13, Lines 3-7; Page 39, Lines 21-26; Page 1, Lines 15-19; Page 5, Lines 14-19; Page 15, Lines 20-21	Col. 6, Lines 29-33; Col. 18, Lines 30-36; Col. 1, lines 10-15; Col. 3, Lines 5-10; Col. 7, Lines 41-42

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Claim No. or Claim Element**	Application	'281 patent
phenotypic characteristic of a cell	Page 8, Line 33-Page 9, Line 1	Col. 4, Lines 51-54
mammalian	Page 39, Lines 21-26	Col. 18, Lines 30-36
34, 40, 44, 53	Claim 15	Claim 15
35, 41, 45, 54	Claim 16	Claim 16
36, 49	Claim 13	Claim 13
37, 50	Claim 14	Claim 14
38, 42, 51, 58	Page 4, Lines 13-16 and Line 35-Page 5, line 2; Page 12, Lines 22-28	Col. 2, Lines 40-43 and 60-63; Col. 6, Lines 14-20
46, 55	Page 8, Lines 29-31; Page 21, Lines 6-10	Col. 4, Lines 48-50; Col. 9, Lines 31-36 (see also Claim 2 of the '655 patent)
47, 56	Page 8, Lines 29-31; Page 21, Lines 6-10	Col. 4, Lines 48-50; Col. 9, Lines 31-36 (see also Claim 3 of the '655 patent)
48, 57	Page 8, Lines 29-31; Page 22, Lines 17-22	Col. 10, Lines 5-20 (see also Claim 5 of the '655 patent)

\*\*These terms appear in independent Claims 33, 39, 43, and 52. The recited support applies for the terms as they appear those claims.

As discussed at the interview, Applicant encloses a copy of the decision in the opposition to Applicant's corresponding European Patent No. 0 403 506, where applicant prevailed over three oppositions, *see, e.g.*, Page 11, Paragraph 17, Line 6 and Page 21, Paragraph 49.

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In view of the foregoing amendments and remarks, it is firmly believed that Claims 33-58 are in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

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Dated:

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Appendix A

33. A method of determining whether a **chemical agent** [substance] **that directly interacts with an enzyme** [protein] is an inhibitor or activator of **that enzyme** [a protein] whose production by a cell evokes a responsive change in a phenotypic characteristic **of the cell**, other than the level of said **enzyme** [protein] in said cell per se, which comprises:

(a) providing a first **mammalian** cell line which produces said **enzyme** [protein] and exhibits said phenotypic response to the **enzyme** [protein];

(b) providing a second **mammalian** cell line which produces the **enzyme** [protein] at a lower level than the first cell line, or does not produce the **enzyme** [protein] at all, and which exhibits said phenotypic response to the **enzyme** [protein] to a lesser degree or not at all;

(c) incubating the **chemical agent** [substance] with the first and second cell lines; and

(d) comparing the phenotypic response of the first cell line to the **chemical agent** [substance] with the phenotypic response of the second cell line to the **chemical agent** [substance].

39. A method of determining whether a **chemical agent** [substance] **that directly interacts with a protein** is an inhibitor or activator of **that** [a] protein whose production by a cell evokes a responsive change in a phenotypic characteristic **of the cell**, other than the level of said protein in said cell per se, which comprises:

(a) providing a first **mammalian** cell line which produces said protein and exhibits said phenotypic response to **the biological activity** of the protein;

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(b) providing a second **mammalian** cell line which produces the protein at a lower level than the first cell line, or does not produce the protein at all, and which exhibits said phenotypic response **to the biological activity of** the protein to a lesser degree or not at all;

(c) incubating the **chemical agent** [substance] with the first and second cell lines, **wherein said chemical agent is suspected of being an inhibitor or activator of the biological activity of said protein; and,**

(d) comparing the phenotypic response of the first cell line to the **chemical agent** [substance] with the phenotypic response of the second cell line to the **chemical agent** [substance].

43. A method of determining whether a **chemical agent** [substance] **that directly interacts with an enzyme** is an inhibitor or activator of **that enzyme** [a protein] which comprises:

(a) providing a **mammalian** test cell which overproduces a selected **enzyme** [protein] relative to a control cell which produces said **enzyme** [protein] at a lower level or essentially does not produce the **enzyme** [protein], and wherein production of said **enzyme** [protein] in said test cell evokes a responsive change in a phenotypic characteristic **of said test cell**, other than the level of said **enzyme** [protein] in said **test cell** per se, which is comparatively greater than in said control cell;

(b) treating said test cell containing the overproduced selected **enzyme** [protein] with said **chemical agent** [substance]; and

(c) examining the treated test cell to determine whether it exhibits a change in said phenotypic characteristic in response to said **chemical agent** [substance].

52. A method of determining whether a **chemical agent** [substance] **that directly interacts with a protein** is an inhibitor or activator of that protein which comprises:

(a) providing a **mammalian** test cell which overproduces a selected protein relative to a control cell which produces said protein at a lower level or essentially does not produce the protein, and wherein production of said protein in said test cell evokes a responsive change in a phenotypic characteristic **of said test cell**, other than the level of said protein in said **test** cell per se, which is comparatively greater than in said control cell;

(b) treating said test cell containing the overproduced selected protein with said **chemical agent** [substance], wherein said **chemical agent is suspected of being an inhibitor or activator of the biological activity of said protein**; and

(c) examining the treated test cell to determine whether it exhibits a change in said phenotypic characteristic in response to said **chemical agent** [substance].